

BINGHAM McCUTCHEN LLP
 DONN P. PICKETT (SBN 72257)
 GEOFFREY M. HOWARD (SBN 157468)
 HOLLY A. HOUSE (SBN 136045)
 ZACHARY J. ALINDER (SBN 209009)
 BREE HANN (SBN 215695)
 Three Embarcadero Center
 San Francisco, CA 94111-4067
 Telephone: (415) 393-2000
 Facsimile: (415) 393-2286
 donn.pickett@bingham.com
 geoff.howard@bingham.com
 holly.house@bingham.com
 zachary.alinder@bingham.com
 bree.hann@bingham.com

DORIAN DALEY (SBN 129049)
 JENNIFER GLOSS (SBN 154227)
 500 Oracle Parkway, M/S 5op7
 Redwood City, CA 94070
 Telephone: (650) 506-4846
 Facsimile: (650) 506-7114
 dorian.daley@oracle.com
 jennifer.gloss@oracle.com

Attorneys for Plaintiffs
 Oracle USA, Inc., Oracle International Corporation,
 Oracle EMEA Limited, and Siebel Systems, Inc.

UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 OAKLAND DIVISION

ORACLE USA, INC., *et al.*,
 Plaintiffs,
 v.
 SAP AG, *et al.*,
 Defendants.

CASE NO. 07-CV-01658 PJH (EDL)

**ORACLE'S OPPOSITION TO
 DEFENDANTS' MOTION TO
 COMPEL**

Date: January 26, 2010
 Time: 2 p.m.
 Place: Courtroom E, 15th Floor
 Judge: Hon. Elizabeth D. Laporte

TABLE OF CONTENTS

		<u>Page</u>
I.	INTRODUCTION	1
II.	SAP’S THREE TOPICS ARE EACH PROCEDURALLY DEFECTIVE.....	2
A.	Each of SAP’s Topics Differs From What It Told the Court and the Court Required of It	2
B.	None of SAP’s Three New Topics Should Be Before the Court	3
1.	The First Topic Re “Mapping” Is Old and Overbroad.....	3
2.	SAP Concedes That Its Second Topic Is Contrary to the Parties’ Agreement	4
3.	The Post-Litigation Custodian Topic Is Not Related to Siebel or to New Claims, as SAP Promised	5
III.	THE COURT ALSO SHOULD DENY EACH OF SAP’S THREE TOPICS FOR MULTIPLE SUBSTANTIVE REASONS	5
A.	A Complete Review of the Facts Demonstrates That the Relief SAP Seeks Re Mapping Is Inappropriate	5
1.	Relevant Chronology of Events	7
a.	August 2006-March 22, 2007: SAP Creates Its Own Mapping Spreadsheets From Customer Connection and Oracle Investigates Downloads.....	8
b.	September 2007-March 2008: Early Discovery and Judge Legge’s Rulings Regarding Mapping	9
c.	April 2008-February 2009: Oracle Produces the Customer Connection Databases	14
d.	March 2009-December 3, 2009: Oracle Provides Technical Help but SAP Takes No Discovery.....	15
e.	December 4, 2009: Mr. Rice Confirms Oracle Had Produced Complete Mapping Information.....	16
2.	The Court Should Deny SAP’s Motion for Further Mapping Information for Any of Five Reasons	18
a.	SAP Knew When It Filed This Motion That It Had the Data It Says Oracle Withheld	18
b.	SAP’s Own Failures to Accept or Pursue More Discovery Preclude Relief on This Issue.....	20
c.	SAP’s Own Contrary Statements and Positions Preclude Relief on This Issue.....	21
d.	SAP Has Suffered No Prejudice	22
e.	SAP’s Requested Relief Invades Oracle’s Work Product and Is Unnecessary, Inappropriate, and Unduly Burdensome	22

TABLE OF CONTENTS
(continued)

		<u>Page</u>
1		
2		
3	1. The Unproduced Documents Are Protected Work Product	23
4	2. There Is No Justification for Invading Oracle's Work Product	23
5	3. Mr. Rice's Spreadsheets Were Produced in a Timely Manner as Part of Expert Discovery.....	24
6	4. Beyond the Inappropriate Request for Relief Invading Work Product, SAP's Requests for Relief Are Unnecessary and Unduly Burdensome	25
7		
8	B. The Court Should Deny SAP's Motion for Discovery of Irrelevant Documents Maintained by Folger Levin.....	25
9		
10	C. The Court Should Deny SAP's Motion to Compel Production of Post-Litigation Documents.....	28
11	1. SAP Long Ago Abandoned Its Improper Request for Post-Litigation Custodians	28
12	2. The Request for Post-Litigation Custodians Was Not Proper per the Expanded Discovery Timeline Agreement Either	29
13	3. SAP's Request For Post-Litigation Custodians Is Unduly Burdensome	30
14		
15	IV. CONCLUSION	30
16		
17		
18		
19		
20		
21		
22		
23		
24		
25		
26		
27		
28		

TABLE OF AUTHORITIESPage**CASES**

<i>Fletcher v. Union Pacific R.R. Co.</i> , 194 F.R.D. 666 (S.D. Cal. 2000).....	24
<i>Hickman v. Taylor</i> , 329 U.S. 495 (1947).....	25
<i>In re Vioxx Products Liability Litigation</i> , No. MDL 1657, 2007 WL 854251 (E.D. La. Mar. 6, 2007).....	23
<i>Khalil v. Transunion, LLC</i> , No. 08-10303, 2008 WL 4642857 (E.D. Mich. Oct. 20, 2008).....	29
<i>U.S. v. Estrada-Lucas</i> , 651 F.2d 1261 (9th Cir. 1980).....	22
<i>Wixon v. Wyndham Resort Dev. Corp.</i> , No. C 07-2361-JSW, 2009 U.S. Dist. LEXIS 86337 (N.D. Cal. Sept. 21, 2009).....	25
<i>Wixon v. Wyndham Resort Dev. Corp.</i> , No. C 07-2361-JSW, 2009 U.S. Dist. LEXIS 86349 (N.D. Cal. July 17, 2009).....	24, 25

OTHER AUTHORITIES

Fed. R. Civ. P. 26(a)(2)	24
Fed. R. Civ. P. 26(b)(2)(C)(iii)	25
Fed. R. Civ. P. 26(b)(3).....	23, 25
Fed. R. Civ. P. 26(b)(3)(A)(ii)	23
Fed. R. Civ. P. 45(c)(3)(A)(iv).....	25

I. INTRODUCTION

The motion filed by Defendants SAP AG, SAP America, Inc., and TomorrowNow, Inc. (collectively, “SAP”) should be denied on both procedural and substantive grounds. The Court should deny it on procedural grounds because SAP has violated the Court’s requirement that the Parties’ final motions to compel should include only three discrete topics, and because the first topic is overbroad (it combines multiple old discovery requests on tangentially-related issues already the subject of past motions, such as Oracle’s communications with its customers (RFP 45)). On November 17, the Court required the Parties to identify two narrow topics for a final motion to compel, with a third to be identified later. SAP identified its first two topics as related to: (1) Siebel and discovery on new claims, and (2) pre-2005 financial information. SAP’s actual motion relates to three different topics. Each topic either violates the Court’s rules regarding scope, contradicts SAP’s representations to the Court about the topics on which it would move, or both.

The Court also should deny each of SAP’s three new topics for a long series of substantive reasons. On the first topic, mis-described by SAP as relating to a single “mapping” topic, SAP confuses two very different concepts, and omits important history that Oracle sets forth below. The confusion arises when SAP says Oracle has “consistently maintained throughout this case that any download-to-product mapping that can be done has to be done manually, on a file-by-file basis.” Motion at 4. Oracle has “maintained” just the opposite, and has produced huge volumes of electronic data and documents to facilitate the automation by SAP of “download-to-product” mapping (data which SAP already had and knew how to generate, despite its contention now that it received it only in November 2009). The quotes from Oracle that SAP cites go to a different issue: there is no automated way to do “download-to-contract” mapping, which involves the analysis of whether an individual download taken by SAP is licensed to a specific customer. This distinction becomes clear through the history of these issues omitted by SAP, history which includes SAP’s own creation, in February 2007, of similar spreadsheets from the same source (Customer Connection), and its request for, and receipt of, the underlying Customer Connection databases from which Oracle generated the very spreadsheet

Case No. 07-CV-01658 PJH (EDL)

SAP claims it did not receive until November 16, 2009. All told, this “mapping” topic fails for at least five reasons, including that SAP had the information at least two years ago, refused Oracle’s offers for more, and now seeks protected work product SAP knew how to create itself as far back as February 2007.

The second topic, related to the Folger Levin files, untimely seeks irrelevant material, such as a five-year old motion *in limine* regarding Larry Ellison’s “character.” The Court should deny the third topic, post-litigation custodians, because SAP abandoned it, made statements to Oracle and the Court that directly contradict it, and because SAP’s delay has increased the undue burden to collect and produce the information.

II. SAP’S THREE TOPICS ARE EACH PROCEDURALLY DEFECTIVE

A. Each of SAP’s Topics Differs From What It Told the Court and the Court Required of It

At the November 17 Discovery Conference, the Parties discussed the topics and scope of this Motion with the Court. The Court required each side to identify two topics, in part to make sure that those topics were sufficiently discrete and fair to both sides in terms of scope:

So, as you know, I like to know a fair amount about the dispute before I decide it in a formal way. And, if I am going to do that, there is going to be a limited number of things I will decide, because I can’t decide them all in time.

Declaration of Zachary J. Alinder in Support of Oracle’s Opposition to Motion to Compel (“Alinder Decl.”), Ex. A at 52:23-53:2; *see also id.* at 54:8-9. The Court also gave specific guidance as to the permissible scope of the topics, responding to one of SAP’s “topics” relating to “new claims”: “I won’t entertain a matter in that amorphous state” and further noting, “you’ll have to narrow it beyond that or I will just say no.” *Id.* at 63:17-18, 67:9-10.

The Parties identified on the record two of a maximum three issues for their final motion to compel, and agreed that on December 4, each side would identify one final discrete issue to the other for inclusion in the motion. *See id.* at 53:9-16, 58:16-19. At the hearing, SAP identified its first motion topic as: “[Siebel] and the new claims-related discovery . . . The things that they added in the fourth amended complaint.” *Id.* at 63:12-14. SAP then identified its

second motion topic as: “pre-2005 damages-related discovery.” *Id.* at 63:25-64:1.

Without seeking leave from the Court or meeting and conferring with Oracle, SAP then identified three different “topics” on December 4: (1) a request for Oracle to review and certify its entire production relating to six different requests, labeled “mapping,” but in reality covering topics ranging from customer communications, to SAP customer license issues, to documents “sufficient to show” the link between SARs and ESUs; (2) a request for production of pleadings and transcripts identified in an index of documents related to the 2003 PeopleSoft/Oracle case that are maintained by Folger Levin; and (3) a request for “updated production[s]” from six Oracle employees. *See id.*, Ex. B. Oracle objected to SAP’s topics, and asked SAP to reconsider, but SAP refused. *See id.*, ¶4. In light of SAP’s disregard for the Court’s instructions, the Court should require SAP to choose one topic between its second and third to pursue, and should not allow SAP to pursue the first, as it is too amorphous.

B. None of SAP’s Three New Topics Should Be Before the Court

1. The First Topic re “Mapping” Is Old and Overbroad

The Court should reject SAP’s first “topic” re “mapping” on **three** procedural grounds.

First, it bears no relation to SAP’s counsel’s promised “placeholder for those things that are still hanging that we can’t articulate the nature of the problem yet, if any.” *Id.*, Ex. A at 53:17-19. The Parties both identified “mapping” as an issue (and had it decided) years ago.

Second, the topic is too broad in its scope and requested relief. The discovery requests for which SAP seeks relief (RFPs 44-45, 47, and 51 and Interrogatory 7), are not one topic. Defendants’ Motion to Compel (“Motion”) at 3. For example, RFP 51 (“Documents sufficient to show all Electronic Software Updates (ESUs) and Software Application Requests (SARs) relating to the Software and Support Materials, and the system code for each such SAR and ESU”) focuses on download-to-product mapping, while others, such as Interrogatory 7 (“For each TN Customer and Named Customer . . .”) and RFP 44 (“All Documents from which a TN Customer or Named Customer can determine. . .”) focus on determining whether a download is licensed to a particular customer, *i.e.*, download-to-contract mapping. *See* Declaration of Scott Cowan in Support of Defendants’ Motion to Compel (“Cowan Decl.”) at Appendices 1-5. Other

requests barely relate to any kind of effort to determine the license status of any download. For example, RFP 45 (“All Documents relating to Communications between Oracle and an TN Customer or Named Customer concerning which Software and Support Materials the customer is entitled to access or Download”) focuses on Oracle’s communications with its customers, and RFP 47 (“All Documents relating to which Software and Support Materials any TN Customer or Named Customer is, or was at any time, entitled to access or Download”) addresses issues of access beyond just downloading. *See* Cowan Decl. at Appendices 2, 3. Despite SAP’s attempt to group these various types of requests together, they involve different issues. Further, RFPs 44, 45, and 47 and Interrogatory 7 were the subject of SAP’s very first motion to compel in this action, decided by Judge Legge. *See* Alinder Decl., Ex. C at 12:3-7.

Third, SAP did not identify Interrogatory No. 7 as included in this “topic” even in the Parties’ mutual exchange on December 4. *See* Alinder Decl., Ex. B. Oracle learned that SAP considered this an issue when Oracle received SAP’s Motion.

Because the discovery requests listed by SAP show that only RFP 51 specifically addresses download-to-product mapping, Oracle focuses below on that issue in the space available. Had Oracle known, and the Court approved, this broad collection of discovery responses within a single topic, Oracle would have requested additional space to address them. To the extent the Court is willing to entertain SAP’s Motion, even after past motion practice on these other requests, Oracle respectfully requests a further opportunity to brief any other issues the Court believes should be addressed.

2. SAP Concedes That Its Second Topic Is Contrary to the Parties’ Agreement

SAP concedes that the second topic it disclosed to the Court – pre-2005 financial information – was “resolved.” Motion at 2. SAP substituted the Folger Levin topic, and justified doing so on the grounds that the topic was “discussed” at the November 17 Discovery Conference. *Id.* That is true but irrelevant. The Parties discussed numerous topics at the hearing, but agreed to leave **one** open topic, and to work to resolve the other two. SAP, like Oracle, had one open topic. Oracle would have liked to have an additional issue in its motion to

1 compel as well, but abided by the agreement and its representations at the November 17
 2 Discovery Conference, and also undertook to avoid motion practice by resolving one of the
 3 issues on which SAP said it would move. Since the equally-undisclosed topic re “mapping” is
 4 impermissibly overbroad (among other defects), at a minimum the Court should require SAP to
 5 use its open topic on this topic or the next, and decline to consider the mapping topic.

6 **3. The Post-Litigation Custodian Topic Is Not Related to** 7 **Siebel or to New Claims, as SAP Promised**

8 SAP contends that its topic of post-litigation custodian document productions relates to
 9 its first disclosed topic, because it relates to Oracle’s “[Fourth Amended Complaint], Plaintiffs’
 10 expanded claims, and Siebel issues.” Motion at 1-2. That is wrong. This new topic only relates
 11 to Oracle’s Fourth Amended Complaint in the sense that **every** issue in the case is now included
 12 in the Fourth Amended Complaint. SAP’s attempt to connect its post-litigation document
 13 request to Oracle’s new claims through the Parties’ Expanded Discovery Timeline Agreement is
 14 inappropriate because (1) that Agreement does not relate to the Fourth Amended Complaint or to
 15 Siebel issues, and (2) the Parties reached that agreement in November 2008, a half-year before
 16 the Parties began negotiating the filing of Oracle’s Fourth Amended Complaint. *See* Declaration
 17 of Jason McDonell in Support of Motion to Compel (“McDonnell Decl.”), Ex. J.

18 SAP’s Motion further proves the point. SAP identifies the subject matter areas for which
 19 it believes these employee documents are relevant – (a) TomorrowNow/SAP customers,
 20 (b) damages causation and mitigation, and (c) TomorrowNow business model documents. *See*
 21 Motion at 19-20; *see also* McDonell Declaration, Ex. J. None of those three topics first appeared
 22 in the Fourth Amended Complaint, nor are they specific to Siebel.

23 **III. THE COURT ALSO SHOULD DENY EACH OF SAP’S THREE** 24 **TOPICS FOR MULTIPLE SUBSTANTIVE REASONS**

25 **A. A Complete Review of the Facts Demonstrates That the Relief** 26 **SAP Seeks re Mapping Is Inappropriate**

27 At the November 17, 2009 Discovery Conference, Oracle objected to SAP’s nine-topic
 28 Rule 30(b)(6) deposition notice related to these downloading allegations. In discussing the
 overbreadth of this notice, the Court observed that downloading had been an original issue in the

case, and indicated that SAP should have taken such broad discovery on that topic sooner. *See* Alinder Decl., Ex. A at 22:6-12, 25:2-24, 27:14-28:10. The Court then granted SAP 25 hours of final deposition discovery, and left the division to SAP (subject to Oracle's objections). *See id.* at 28:3-9. SAP then voluntarily **cancelled** the downloading deposition (to use its time on other topics) and filed this Motion instead, the ultimate thrust of which is to preclude Oracle from introducing evidence of SAP's illegal downloading at trial.

As part of this second effort to recover from not taking downloading discovery, SAP's Motion confuses two important issues: download-to-product mapping, which means associating a download with its corresponding Oracle product, and download-to-contract mapping, which means actually looking at the individual contracts to determine whether a specific download related to a specific customer was licensed. Oracle has always agreed that download-to-product mapping information exists in electronic form and, as shown below, has produced everything to SAP it has requested and that it needed on that topic. The statements by Oracle that SAP says are misleading relate to a different issue than the one SAP complains about in its Motion – they relate to download-to-contract mapping, which cannot be automated and which Oracle did not automate. Those statements by Oracle, selected by SAP out of context, are as true today as they were when Oracle made them: Oracle did the hard, time-consuming work of matching up downloads to individual customer contracts to determine licensed status, and SAP will have to do it too. In addition to this basic confusion between the two types of mapping, SAP's Motion fails for at least **five** additional substantive reasons, each of which independently warrants denial:

1. Since as early as February 2007, and no later than January 2008, SAP has had the **same download-to-product data** reflected by the spreadsheets identified in SAP's Motion. SAP used its own former JD Edwards employees to generate its own similar spreadsheets from the same source (Customer Connection) long ago, and it had those same databases in its physical possession in February 2009.
2. SAP is estopped by its own failures to take or accept more discovery than it did, including its rejection of Oracle's offer to produce work product spreadsheets in January 2008 and its failure to pursue the engineer assistance Judge Legge ordered (which SAP's experienced JD Edwards employees did not need anyway).
3. SAP is estopped from the argument it now makes by its own contrary statements, failures to disclose what it already had, and positions about what it already had

and what it needed.

4. SAP has suffered no prejudice.

5. Any download-to-product material SAP now seeks beyond what Oracle has already provided is work product and SAP cannot justify invading that protection. Accordingly, the relief SAP seeks is unrelated and disproportionate to the requests it made.

Oracle has provided the Court with the Declaration of Buffy Ransom and the exhibits attached to it, including the same PowerPoint slides Oracle presented to Judge Legge and SAP at the Parties' first motion to compel hearing on February 13, 2008. Declaration of Buffy Ransom in Support of Oracle's Opposition to Motion to Compel ("Ransom Decl."). Ms. Ransom describes the meaning of mapping, as it relates to the system codes found in the licensed portions of JD Edwards software, and the support products related to that software. Ransom Decl., ¶¶3-9. She explains the difference between mapping **downloads to products** (download-to-product), and mapping **downloads to specific customer contracts** (download-to-contract). *Id.* Oracle also provides the prior Declaration of Jason Rice, provided to SAP and the Court on March 14, 2008, which gives background regarding the Customer Connection databases discussed at length below. *See* Alinder Decl., Ex. D. These databases contain within them all of the system codes associated with all of the downloads and related product information available on Customer Connection at the time Oracle copied them. As the discussions regarding mapping trace back to the beginning of the case, it is necessary, with this backdrop in mind, to set forth a far more detailed record than what SAP included in its Motion. After doing so, Oracle then returns to the five substantive reasons why the Court should deny the Motion.

1. Relevant Chronology of Events

Footnote 8 of SAP's Motion supposedly supports the argument heading that SAP has "continuously sought all electronic download-to-product mapping in Plaintiffs' possession." The footnote hints at a story not told by SAP's Motion. The first three dates on which SAP says it sought download-to-product mapping information are November 19, 2007, December 12, 2007, and January 28, 2008. However, the next date identified by SAP is not until June 16, 2009 (and SAP did not request anything then, as explained below). This gap is telling, but the history is

1 even worse for SAP.

2 **a. August 2006-March 22, 2007: SAP Creates Its**
 3 **Own Mapping Spreadsheets From Customer**
 4 **Connection and Oracle Investigates Downloads**

5 Prior to its Complaint, Oracle identified massive downloads from Customer Connection
 6 originating from a TomorrowNow IP address. Oracle undertook a time-consuming analysis of
 7 its download logs to isolate the downloads, and the credentials used to take them, and then to
 8 determine which ones were unlicensed. *See* Ransom Decl., ¶3. There is no automated way to do
 9 this download-to-contract analysis. *See id.*, ¶¶3-10. Oracle laid out the non-privileged factual
 10 details and conclusions of the investigation in its Complaints and interrogatory responses. *See,*
 11 *e.g.*, Fourth Amended Complaint (“FAC”) ¶¶ 97-100, Dkt. No. 418; *see also* Alinder Decl., ¶7 &
 12 Ex. E (investigation directed by counsel, including creating certain spreadsheets that correlated
 13 system codes from the JD Edwards downloads to JD Edwards products); *see also* Cowan Decl.,
 14 Ex. C (Interrogatory No. 7).

15 SAP, unbeknownst to Oracle, also used Customer Connection to generate very similar
 16 spreadsheets in the same time period. Attached as Exhibit F to the Alinder Declaration (and
 17 submitted in full on CD due to its size as Exhibit G), are excerpts from a 3,500+ page document
 18 created in February 2007 (according to the metadata), just days apart from the Jason Rice
 19 spreadsheet SAP says Oracle improperly withheld. SAP produced this spreadsheet from the files
 20 of SAP’s former Director for North American Support Services, Mark Kreutz, an experienced
 21 former JD Edwards and Oracle employee, and one of seven employees SAP retained as a paid
 22 litigation consultant after it shut down TomorrowNow in October 2008. Alinder Decl., ¶¶9, 13
 23 & Ex. H. SAP produced this 2007 spreadsheet in February 2009 (labeling it “minor clean-up”),
 24 more than a year after the initial Kreutz document production (and his deposition), and three
 25 days after Oracle produced the Customer Connection databases. Alinder Decl., ¶9.

26 The February 2007 Kreutz document was apparently created using access to Customer
 27 Connection, and contains detailed information linking downloads to their related products. Rice
 28 Decl., ¶ 6. Indeed, the first ESU on the Kreutz document is the same as the first one on the Rice
 Spreadsheet, and contains virtually the same SAR, Object, and system code information. *See*

Alinder Decl., ¶11 & Ex. LL at 216:17-218:11.

At a minimum, the Kreutz document and others like it from SAP's files evidence detailed knowledge about how to use Customer Connection to generate exactly the type of spreadsheet that SAP complains about in this Motion. SAP employees have admitted as much in deposition. Keith Shankle, another former SAP employee, who reported up to Mr. Kreutz, created a "master" SAR spreadsheet to catalogue all the SARs on Customer Connection and index them by system code:

Q. Did you populate a spreadsheet with every SAR available from Customer Connection for certain JD Edwards World subsets?

A. Yes.

Q. How did you do that?

A. I used the Customer Connection to get that information.

Alinder Decl., Ex. I at 79:14-20, 114:4-17. A later version of the spreadsheet Shankle was referring to above shows that between August 2006 and February 2007, Shankle scoured Customer Connection to collect and index system code and product information for SARs across 20 different update levels for both major releases of JDE World software, making more than 27,000 mapping determinations. *Id.* at ¶12 & Exs. K and L.

b. September 2007-March 2008: Early Discovery and Judge Legge's Rulings Regarding Mapping

Beginning on September 21, 2007, with its initial production of customer contracts, Oracle began producing mapping information that would enable SAP to perform the same type of download-to-contract mapping analysis that Oracle performed prior to filing the Complaint. *See, e.g.,* Alinder Decl., ¶ 15. The Parties met and conferred regarding SAP's request for download-to-product mapping information. *See, e.g., id.,* Ex. N & ¶16. Throughout these discussions, Oracle made clear that it did have, and could create, spreadsheets to link system codes to products – **and offered to provide them**, as explained below. *See id.,* Ex. N at 2-3 & ¶16. SAP did not disclose that it already had similar ones.

On November 19, 2007, SAP asked for "information and documents that map the Oracle products at issue in this case to the Software and Support Materials available on Customer

1 Connection to which Oracle believes a licensee of these products is entitled.” Cowan Decl., Ex.
 2 L. On November 27, 2007, Oracle responded (in relation to RFPs 44-47): “As discussed on
 3 November 16, 2007, we have collected documents that tie together system codes and the
 4 software modules for the JD Edwards SSMs that TomorrowNow downloaded on behalf of its
 5 customers. We’ll review these documents and will produce them as soon as reasonably possible
 6 in a meta-data scrubbed native form for word tables and excel files” Alinder Decl., Ex. O at
 7 2. (The Parties use “SSM” to refer to the software and support materials available on Oracle’s
 8 support websites.)

9 In the same letter, Oracle separately responded to SAP’s complaint about the RFP 51
 10 response: “SAP is also not entitled to SAR and ESU information unrelated to the SSMs that it
 11 took, unless it contends that it took every available SAR and ESU improperly (which may well
 12 be the case, but Oracle has not yet made that allegation).” *See id.*, Ex. O at 4. This was a key
 13 point. Oracle did not, at that time, know what SAP had on its systems because Oracle did not yet
 14 have that discovery from SAP.

15 Oracle produced certain pre-existing spreadsheets and related documents that provided
 16 download-to-product mapping SAP had requested. *See* Alinder Decl., ¶15 & Ex. P. Oracle did
 17 not produce other, work product spreadsheets with download-to-product information (such as the
 18 one SAP identifies in its Motion) because it did not want to risk any waiver argument. *See*
 19 *id.*, ¶15. On January 4, 2008, Oracle explained by letter to SAP that Oracle had granted SAP
 20 access to Customer Connection, which provided “the product mapping information.” *Id.*, Ex. N
 21 at 2-3. Through that access, as evidenced by the February 2007 Kreutz document that SAP
 22 produced in February 2009 and confirmed by Kreutz’s Rule 30(6)(6) testimony and in the Rice
 23 Declaration, SAP could have recreated, at that time in January 2008, an index of system codes
 24 and ESUs, exactly like the spreadsheet created by Jason Rice and produced with Oracle’s Expert
 25 Report. *See id.*, ¶¶9-12, 45 & Exs. F, G, I, K, L, LL, and SS; Rice Decl., ¶¶3, 5-6.

26 But Oracle went even further: it offered to create “spreadsheets that link the system
 27 codes for the JD Edwards SSMs to the licensed support product” provided SAP would agree to
 28 three conditions: “if you agree that you will not (1) claim that Oracle has waived any privileged

1 or immunity, including but not limited to work product protection; (2) request any other data that
 2 Oracle has compiled in the process of creating the system code mapping we will produce, or (3)
 3 attempt to depose any Oracle consulting expert or attorney regarding the preparation of the
 4 system code documents.” Alinder Decl., Ex. N at 2-3. Oracle did not make up these conditions.
 5 It took them, almost verbatim, from a similar offer made by SAP in October 2007, and accepted
 6 by Oracle, prior to SAP’s production of a work product TomorrowNow network topology map.
 7 *See* Alinder Decl. Ex. Q.

8 SAP rejected Oracle’s offer on January 24, 2008. *See id.*, Ex. R. This response affirmed
 9 Oracle’s concerns about creating or producing work product, which it otherwise had no
 10 obligation to do (see below, Section (III)(A)(2)(e)). Instead, on January 25, 2008, Oracle
 11 produced detailed pre-existing spreadsheets (*i.e.*, not ones created at the direction of counsel or
 12 experts related to the litigation) that it had located showing how the system codes for the JD
 13 Edwards downloads related to software licensed by customers in their license contracts. *See*
 14 *id.*, ¶15 & Ex. P. These spreadsheets contain electronic download-to-product information similar
 15 to the information contained in the spreadsheets that are the subject of SAP’s Motion (and found
 16 in SAP’s own files). *See id.*, ¶18.

17 At the ensuing February 13, 2008 hearing, from which SAP selectively quotes in its
 18 Motion, SAP acknowledged Oracle’s production of download-to-product information, and said
 19 so to Judge Legge: “**So what Oracle has provided us is the link between the system code and**
 20 **the licensed product.**” Alinder Decl., Ex. C at 27:3-4. Thus, that hearing did **not** focus on
 21 whether Oracle had produced adequate download-to-product mapping, because SAP counsel
 22 confirmed that Oracle had produced that information. Rather, the “mapping” focus of that
 23 proceeding related to SAP’s ability to automate the determination of whether the specific
 24 downloads on its system were licensed (*i.e.*, download-to-contract mapping).¹ *See id.* at 15:21-
 25

26 ¹ While the quotes contained in this Opposition identify some key points made during the
 27 February 13, 2008 hearing, Oracle encourages the Court to review the relevant portion of the
 28 hearing transcript as a whole (provided as Exhibit C to the Alinder Declaration).

25. Mr. Cowan reiterated: “Really, the issue is what data do they have in their possession that will speed the analysis of the TomorrowNow downloaded files, **to allow us to segregate those things that our customers are rightfully entitled to under their licenses**, and those things that we both agree they shouldn’t have under their licenses.” *Id.* at 22:25-23:5 (emphasis supplied). Judge Legge verified this key point “in English”:

LEGG: In English, what you want is a mapping system which relates the subfiles, as I recall them here, to the products, **and to the contracts**. Is that right?

MR. COWAN: Correct.

Id. at 32:20-24 (emphasis supplied). Judge Legge **then** asked Oracle “Do you have, presently existing, any mapping device or program or code which would eliminate the necessity for doing it [*i.e.*, mapping downloads to products to **contracts**] one by one?” to which Oracle responded “The answer to that, Your Honor, is: ‘Not that we have been able to generate so far.’ We’re still working on it, because we have the same interest in this that they do.” *Id.* at 33:6-12. That was true then, and is true now. There still is no automated program that will tie a customer’s license agreement to any particular download.

Judge Legge’s Order further confirmed these points: “Defendants want more detail in the mapping information, primarily to relate the information directly to defendants’ sub-files, and the connections between the sub-files, the products **and the contract**. . . .” and recommended “that Oracle be directed, at its expense, to send an engineer . . . to the premises of defendants to work with one of defendants’ engineers to see if a method of access can be developed.” Cowan Decl., Ex. E at 4:3-16 (emphasis supplied). Judge Legge also ruled that it is SAP’s burden to determine the licensed status of each download because license is an affirmative defense. *See id.*, Ex. E & Ex. S at 119:15-25. Oracle prepared to send its engineer as Judge Legge had instructed. *See id.*, ¶23 & Ex. W at 6.

On February 19, 2008, SAP filed another motion to compel, seeking: (1) the source code for “Change Assistant” and (2) Customer Connection’s underlying databases. *See Alinder Decl.*,

Ex. U.² In that motion, SAP said (in language not disclosed or referenced by the timeline in footnote 8): “Moreover, the databases that Change Assistant uses to perform its search and retrieval functions will provide part of the data defendants continue to seek regarding the mapping of all downloadable software and support materials to all of the licensed products that are implicated by Oracle’s claims in this case.” *Id.* at 7.

As described in Oracle’s responding papers, these databases comprised 1.2 Terabytes of data, from “at least nine separate databases” and “approximately 65 million individual records.” Alinder Decl., Ex. T at 8. Oracle disagreed that production was necessary or appropriate because Oracle had already “allowed Defendants unfettered access to inspect Customer Connection with a special log-in credential, and even allowed them to download SSMs using the Change Assistant tool.”³ *Id.* at 8. Nevertheless, Oracle agreed to produce these databases related to this further request for “mapping” information as a compromise to resolve the request for Change Assistant, its source code, and the Customer Connection databases. *See id.*

Dissatisfied with this proposal, SAP continued to press for the Change Assistant source code, in a further round of briefing to Judge Legge. Alinder Decl., Ex. V. Oracle again explained the necessity of matching downloads to individual contracts to determine whether the download was licensed. *Id.*, Ex. W at 3. Oracle reiterated its offer to produce these databases, but continued to object to producing the source code. *See id.* With its brief, Oracle **also submitted a declaration from Jason Rice** explaining the nature of the Customer Connection databases and the function of Change Assistant to search them by system code. *See* Alinder Decl., Ex. D at ¶¶4-5. SAP never sought to depose Jason Rice after receiving this declaration, and only ever sought to depose him related to communications between him and Oracle’s experts as disclosed in Oracle’s November 16, 2009 Expert Reports. *See* Alinder Decl., ¶28. Oracle

² Change Assistant was a tool developed by Oracle for its customers to facilitate downloading of SSMs, including from Customer Connection. SAP used Change Assistant as one means of downloading from Oracle prior to the lawsuit, and as part of the 2008 access provided by Oracle.

³ After two days of this access, SAP requested no further access to Customer Connection for almost two years, and not until less than a month before the close of discovery. *See* November 10, 2009 Joint Discovery Conference Statement at 34, Dkt. No. 547.

also reiterated that it was “prepared to sit down with one of its engineers at SAP’s offices to examine those files and assist in the [download-to-contract] mapping exercise” pursuant to Judge Legge’s February 22, 2008 Order. *See id.*, Ex. W at 6.

On March 19, 2008, Judge Legge denied the request for Change Assistant source code, and agreed with Oracle’s proposed compromise of producing the Customer Connection databases, along with the engineer assistance. *See id.*, Ex. X (the Report and Recommendation as to that issue became final on April 9, 2008). From that time until the nine-topic Rule 30(b)(6) deposition notice discussed with the Court on November 17, 2009, SAP did not ever make another **request** for any mapping information.

c. April 2008-February 2009: Oracle Produces the Customer Connection Databases

After the March 19, 2008 Order, Oracle set about the time-consuming task of producing the Customer Connection databases. *See Alinder Decl.*, ¶30. According to Oracle’s records and recollection, SAP never asked about the status of the production. *See id.* By December 2008, Oracle had a set of the databases it was preparing for production, told SAP so, and further informed SAP that the databases also addressed certain pending copyright discovery issues. *See id.*, ¶30 & Exs. Y and Z. To Oracle’s surprise, SAP requested that Oracle prioritize other productions over the Customer Connection databases it had requested, including on January 30, 2009, stating: “Also, it appears from a number of your emails that the production of the Customer Connection database is slowing down Oracle’s production of other documents. We are still not clear why Oracle is prioritizing production of that database over [custodial] documents that we have actually requested.” *Id.*, Ex. AA.

Oracle produced the databases on February 9, 2009, and reminded SAP on February 13, 2009 that “the Customer Connection databases on drives labeled, ORCL062 and ORCL063 . . . contain large amounts of descriptive information concerning Oracle’s software and support materials, including unregistered works.” *Id.*, Ex. BB. The timing compares favorably to SAP’s own production of its downloaded SSMs (a necessary piece of the mapping exercise, according to Mr. Cowan at the February 13, 2009 hearing: “I think you need a combination of both,

1 because you need the Oracle data that Mr. Howard has just presented to you – and we don’t
 2 dispute any of the things he just said, in terms of the type of data and what it means.”). *Id.*, Ex. C
 3 at 22:20-24. SAP began that process in mid-2007 and did not produce them until October 29,
 4 2008 (approximately twice as long as it took Oracle to produce the Customer Connection
 5 databases). *See id.*, Ex. CC at ¶15.

6 **d. March 2009-December 3, 2009: Oracle Provides**
 7 **Technical Help but SAP Takes No Discovery**

8 It was not until March 9, 2009, that SAP raised concerns about accessing the databases.
 9 *See Alinder Decl.*, ¶36. Oracle responded on March 20, 2009 with further assistance. *See id.*
 10 On April 3, SAP requested assistance from Oracle in restoring the databases, which Oracle
 11 provided including by emails dated April 14 and 20. *See id.*, ¶36 & Exs. DD and EE. After SAP
 12 agreed that doing so would not waive work product, Oracle created a thirteen-page technical
 13 instructional document with step-by-step instructions of how to restore and access the “Update
 14 Center” database (one of the Customer Connection databases). *See id.*, ¶36 & Ex. EE. Mr. Rice
 15 confirmed during his deposition these databases were a primary source of the data that SAP
 16 complains of in this Motion. *Cf. id.*, Ex. EE & Ex. FF at 119:7-9 (both discussing the Update
 17 Center databases). Oracle explained that these instructions “should be self-explanatory for your
 18 experts, but if you have questions, please let me know.” *See id.*, Ex. EE. SAP never responded
 19 with further questions. *See id.*, ¶36.

20 In May 2009, Oracle conformed its Interrogatory No. 7 response to reflect the earlier-
 21 provided Customer Connection databases and download-to-product electronic data provided in
 22 early 2008. *See Cowan Decl.*, Ex. C. SAP incorrectly states it then requested additional
 23 mapping information in June 2009. *See Motion* at 12 n.8. The truth is that SAP merely *asserted*
 24 that it did not have the mapping information it needed in connection with *Oracle’s* motion to
 25 compel further responses to Interrogatories 13 and 14 (which requested SAP to support its
 26 statements that it had taken “inappropriate” downloads from Oracle and to identify them). *See*
 27 *Cowan Decl.*, Ex. O at 9.

28 Despite having long had all the download-to-product mapping information and data, as

described above, SAP maintained otherwise in its supplemental responses, ordered by the Court and served on September 23, 2009. *See* Alinder Decl., Ex. GG. Surprised, Oracle responded on October 13 by again detailing all of the “mapping” information, including the electronic spreadsheets produced in February 2008, that SAP had in its possession. *See* Cowan Decl., Ex. J at 2 (“Oracle has produced more download, mapping and licensing information to Defendants than it had when it first analyzed Defendants’ illegal downloading . . .”).

SAP did not respond to Oracle until November 2, 2009, when it served the nine-part Rule 30(b)(6) deposition notice on “mapping” topics. *See* Alinder Decl., ¶39 & Ex. HH. At the November 17, 2009 Discovery Conference, the Court recommended that SAP seek information on a more informal basis than its deposition notice, and Oracle agreed to provide it. *See id.*, Ex. A at 28:6-10. SAP did not proceed with its “mapping” deposition, using its allotted deposition hours examining other witnesses and on other Rule 30(b)(6) topics, and never requested any further “mapping” information from Oracle prior to its Motion. *See id.*, ¶19.

e. December 4, 2009: Mr. Rice Confirms Oracle Had Produced Complete Mapping Information

All this brings us to Jason Rice’s deposition on December 4. The only basis that SAP presents in support of its serious claim that Oracle has been withholding “critical” mapping documents is that deposition and related spreadsheets created by Mr. Rice that were produced with Oracle’s Expert Report. Motion at 4.

Mr. Rice is an Oracle software engineer who assisted Oracle’s attorneys with technical issues during the investigation leading up to the filing of the Complaint and with technical requests from Oracle’s technical expert, Kevin Mandia. *See* Alinder Decl., ¶37. Though omitted from SAP’s papers, at his deposition, Mr. Rice confirmed what the chronology above reveals – SAP has had this same data in its possession for almost a year, and could have queried that data (and did) to create the same spreadsheets that SAP cites in its Motion.

Mr. Rice explained: “Off the top of my head, we provided the SAR system database, we provided the Update Center database, and then we provided every single EnterpriseOne database that was listed at the point of time of collection, which would have been Xe, ERP 8, 8.9, 8.10,

8.11, 8.11SP1, 8.12.” *Id.*, Ex. FF at 112:6-11; *see also id.*, Ex. DD (April 14 email from Alinder to Charrington confirming the same). Mr. Rice confirmed what SAP’s own Kreutz and Shankle spreadsheets prove, and which SAP knew, that the databases could be accessed to create these same types of spreadsheets:

- “Q. And what did you validate? A. I validated more or less the same table information that you could do the queries similar to what I did to produce these types of documents.” *Id.*, Ex. FF at 110:20-23.
- “A. You could run queries to get the same data back, yes. Q. The same data that you had done – A. That created these artifacts that we discussed today.” *Id.* at 117:4-8.
- “Q. This [Exhibit] was taken out of what database? A. The – That would be the Update Center database.” *Id.* at 119:7-9.

The heart of SAP’s Motion is the contention that Mr. Rice’s spreadsheets represent “substantial and critical portions of [Oracle’s] mapping information [that] were not produced by Plaintiffs” until Oracle’s expert reports were produced. Motion at 8. SAP accuses Oracle of withholding these spreadsheets and at the same time “consistently maintain[ing] throughout this case that any download-to-product mapping that can be done has to be done manually, on a file-by-file basis.” *See id.* at 4. Neither of those statements is true. As the chronology above shows, and Mr. Rice’s testimony confirms, Oracle has actually always maintained the **opposite**, disclosing and providing to SAP, beginning in January 2008, multiple sources of electronic data to map downloads to products. SAP knew prior to its Motion that it had all of these data sources, including the databases Mr. Rice used to generate the spreadsheets that SAP cites in the Motion.

SAP’s real problem, as described by SAP counsel and confirmed by Judge Legge, is its inability to easily map the individual downloads on SAP’s systems to individual customer license agreements, in part because SAP did not keep track of what credentials it used to take any of the 9 million downloads on its systems. Alinder Decl., ¶¶40-47 & Exs. II-NN. **That** is what Oracle has “consistently maintained” it cannot provide. Oracle has explained many times, and reiterates again now, that this license mapping can be done, but there is no existing automated way to do it to Oracle’s knowledge. *See id.*, ¶48; *see also* Ransom Decl., ¶¶3-10.

1 **2. The Court Should Deny SAP’s Motion for Further**
 2 **Mapping Information for Any of Five Reasons**

3 Having set forth the detailed record of relevant events preceding SAP’s Motion, Oracle
 4 returns to the five distinct substantive reasons that SAP’s Motion fails.

5 **a. SAP Knew When It Filed This Motion That It**
 6 **Had the Data It Says Oracle Withheld**

7 SAP had all of the necessary mapping information in its possession in at least *seven*
 8 different forms. SAP knew all of this before filing this Motion.

9 **First**, SAP’s Motion claims that the “critical” information it lacked was an “electronic
 10 spreadsheet showing which system codes relate to each ESU, SAR, and object that is available
 11 for downloading would be very useful in that exercise.” Motion at 5. SAP’s own documents,
 12 data, and Rule 30(b)(6) testimony disprove this contention. SAP created that mapping data
 13 itself, as part of its regular business practices, at least as early as February 2007, before Oracle
 14 filed its Complaint and before Jason Rice created the earliest spreadsheet for Oracle’s
 15 investigation cited in SAP’s Motion. *See* Alinder Decl., ¶¶9-12, 45 & Exs. F, G, I, K, L, LL, and
 16 SS; Rice Decl., ¶¶3, 5-6.

17 Not only did SAP have at least 37 former JD Edwards employees, who likely knew
 18 which system codes related to which products, but it hired Mark Kreutz, a former longtime JD
 19 Edwards employee and former Director of North American Support Services at TomorrowNow,
 20 to be its litigation consultant during this case. Alinder Decl., ¶¶ 13-14 & Ex. H; Rice Decl., ¶¶5-
 21 6. Mr. Kreutz maintained his own “massive” Customer Connection spreadsheet – to use SAP’s
 22 term – that lists SARs, ESUs, and Objects almost identical to the Rice Spreadsheet that SAP
 23 complains about, and testified that he understood and maintained instructional documents about
 24 how Customer Connection and system code mapping worked. *See* Alinder Decl., ¶¶9-11, 45 &
 25 Exs. F, G, LL, and SS. Indeed, the first ESU on the Kreutz document is the same as the first one
 26 on the Rice Spreadsheet, and contains similar information about SARs and Objects that tie to
 27 system codes. *See id.*, ¶11. The Shankle documents and testimony reveal the same knowledge
 28 regarding how to compile electronic download-to-product mapping spreadsheets from Customer

1 Connection. *See id.*, ¶12 & Exs. I, K, and L.

2 That SAP claims now that it had no idea this was possible from Customer Connection is
 3 belied by its documents, its testimony, and experience. The fact is that knowing how the system
 4 codes related to the JD Edwards products was the job of over 30 experienced TomorrowNow
 5 employees, and as Shankle testified, was basic and obvious to them: “The system codes are
 6 standard system codes in the JD Edwards software. It’s the basis of how the software was
 7 originally designed.” Alinder Decl., Ex. I at 114:11-13. Accordingly, SAP’s own documents
 8 and testimony expose the fundamental flaw of its Motion – before Oracle even filed its
 9 Complaint, SAP had the very “mapping” information that it claims surprised it at the December
 10 4, 2009 deposition, it had former JDE employee experts as employees and litigation consultants
 11 to explain this to it, and it had access to Customer Connection where all of this data resided.

12 **Second**, SAP had litigation access to all of the mapping information available on
 13 Customer Connection starting on January 3-4, 2008. *See id.*, ¶49. For example, the Customer
 14 Connection website classifies all of the JD Edwards support materials by software release and
 15 product version. *See* Ransom Decl., ¶6. Those support materials can be searched and
 16 downloaded by system code. *See id.*; *see also* Rice Decl., ¶3. Oracle told SAP this by letter on
 17 January 4, 2008. *See* Alinder Decl., Ex. N. SAP could have accessed, inspected, and
 18 downloaded any support materials, including all ESUs or SARs. *See* Sections III(A)(2)(b)-(c),
 19 above.

20 **Third**, in January 2008, Oracle produced to SAP extensive pre-existing spreadsheets
 21 with download-to-product mapping information. *See* Section III(A)(1)(b), above.

22 **Fourth**, Oracle served detailed interrogatory responses explaining Oracle’s own process
 23 for mapping downloads to customer licenses. Oracle also explained this process to SAP and
 24 Judge Legge, using the PowerPoint slides attached as Exhibit A to the Ransom Declaration at the
 25 February 2008 motion to compel hearing.⁴ *See* Alinder Decl., ¶50. Oracle also identified, on

26
 27 ⁴ *See* Ransom Decl., ¶¶3-9 for a description of these slides and the process for mapping
 28 downloads to customer licenses.

September 21, 2007, the employees that had been involved in the process should SAP have wanted to depose them (SAP declined to use any of its 450 deposition hours this way). *See id.*, Ex. E.

Fifth, Oracle has produced the customer license agreements, support renewal information, and customer website terms of use, which Oracle had used to evaluate licensing of the downloads that SAP took as reflected in Oracle's log files.⁵ *See id.*, ¶15.

Sixth, Oracle has produced its log files showing the downloading activity Oracle can identify from its own records. *See id.*

Seventh, at SAP's request, Oracle produced the underlying 65-million record Customer Connection databases on February 6, 2009. *See id.*, ¶52. SAP knew about the mapping information in these databases from multiple sources, and (though omitted from SAP's Motion) received further confirmation from Jason Rice on December 4, 2009. *See* Sections III(A)(1)(c)-(e), above. With these databases, SAP can create any spreadsheet it chooses and has access to the JD Edwards mapping data available through Customer Connection, even though Customer Connection is no longer available for live access. *See* Alinder Decl., Ex. II at 117:4-8.

b. SAP's Own Failures to Accept or Pursue More Discovery Preclude Relief on This Issue

SAP is also estopped by at least *seven* of its own discovery decisions. **First**, SAP rejected Oracle's offer to produce additional, work product, spreadsheets in January 2008. *See* Section III(A)(1)(b), above. **Second**, SAP abandoned its inspection of Customer Connection, which SAP knew had product mapping information, after just two days in January 2008, and did not request further access until November 2009 (which Oracle promptly provided). *See* Section III(A)(1)(d), above; *see also* Alinder Decl., ¶49. **Third**, SAP failed to take advantage of the assistance of an Oracle engineer to help develop a mapping solution, as ordered by Judge Legge. *See* Section III(A)(1)(b), above. **Fourth**, SAP asked Oracle to not prioritize the production of

⁵ In addition to these sources of licensing information, SAP has additional customer licensing information at its disposal in the customer-specific financial reports supplementing the customer contract production. *See* Alinder Decl., ¶51.

the very Customer Connection databases it had requested. *See* Alinder Decl., Ex CC. **Fifth**, SAP failed to depose any of the Oracle employees knowledgeable about the technical details of downloads or Customer Connection until the last day of discovery (and only then on the supposed ground of communications with experts). *See id.*, ¶28. SAP had Jason Rice’s declaration describing the Customer Connection databases in March 2008, it had his name from Oracle’s interrogatory responses in September 2007, and it had ample opportunity to take Rule 30(b)(6) or individual deposition testimony to explore any or all of these issues. *See id.*, Exs. D & E. **Sixth**, SAP voluntarily withdrew its Rule 30(b)(6) “mapping” deposition notice, set for December 1, 2009, after the Court suggested that SAP obtain download information informally instead. *See id.*, ¶19. **Seventh**, SAP ignored this suggestion and (again) did not pursue the suggested informal exchange. *See id.*

**c. SAP’s Own Contrary Statements and Positions
Preclude Relief on This Issue**

SAP’s Motion also takes at least **four** positions that contradict what it has said, done, and not done.

First, SAP had in its possession detailed electronic spreadsheets that map system codes to SARs and ESUs, created from Customer Connection by JD Edwards experts who SAP later retained as litigation consultants. *See* Section III(A)(1)(a), above. SAP never disclosed or produced these spreadsheets prior to the relevant depositions, and never asked Oracle to confirm their accuracy or to send the engineer ordered by Judge Legge to evaluate them.

Second, SAP engaged in a similar mapping exercise before it filed its Answer, as part of its investigation, and has objected to producing any documents generated through that process on work product grounds. *See* Alinder Decl., Ex. OO. Indeed, the Parties stipulated that they would not list on privilege logs documents created after Oracle filed its Complaint. To the extent SAP now changes course and wants to throw open the gates to work product created by each side in its own investigation, a position contrary to the stipulation and all of SAP’s discovery responses, then SAP must produce its own privilege log and the review, certification, and production must go both ways. Oracle submits that such an exercise makes no sense in this case and at this late

1 date.

2 **Third**, SAP contends that it need not disclose work product relied upon by experts until
3 expert reports, which is what Oracle did here. *See* Alinder Decl., ¶54; *see also* Stipulation
4 Regarding Expert Discovery, Dkt. No. 275, at 1.

5 **Fourth**, Judge Legge has ruled, SAP has accepted, and it is now law of the case that it is
6 SAP's burden to do its own time-consuming download-to-contract mapping. *See* Cowan Decl.,
7 Ex. E at 3-4; Alinder Decl., Ex. S at 119:15-25; *U.S. v. Estrada-Lucas*, 651 F.2d 1261, 1263-64
8 (9th Cir. 1980) ("A decision of law in a case, once made, becomes the 'law of the case,' and
9 should not be changed absent clear error in the original ruling or a change in the relevant
10 circumstances."). As SAP said in opposing Oracle's motion to compel, "[Oracle] can do that
11 [analysis] as easy as we could . . . The data is there." *See, e.g.*, Alinder Decl., Ex. PP at 24:18-22.

12 **d. SAP Has Suffered No Prejudice**

13 SAP has suffered no prejudice for **two** reasons. **First**, to the extent it seeks download-to-
14 product mapping information, it had that, as shown above. **Second**, other than the credentials
15 reflected on the logs Oracle has produced, SAP has admitted it cannot do a full download-to-
16 contract analysis for the downloads on its systems regardless of what Oracle provides because it
17 does not have, and cannot re-create, the customer credential used for any given download on its
18 system. *See id.*, ¶40 & Ex. II, Ex. JJ at 43:10-19 and Ex. KK at 570:17-571:2. Further, SAP has
19 also admitted to huge volumes of downloads that exceed the contract rights of the customers
20 whose credentials it used. *See id.*, ¶44 & Ex. JJ at 45:16-25, 123:18-124:1, Ex. KK at 578:12-16,
21 583:2-6, Ex. LL at 171:2-11, Ex. MM at 138:12-22 and Ex. NN at 72:18-75:9. Thus, SAP's
22 license analysis, which is its affirmative burden, could not get off the ground because it cannot
23 map most of its 9 million downloads to a customer license, either in a manual or automated way.

24 **e. SAP's Requested Relief Invades Oracle's Work**
25 **Product and Is Unnecessary, Inappropriate, and**
26 **Unduly Burdensome**

27 SAP's failure to take downloading discovery does not justify access to Oracle's pre-trial
28 work product or other unnecessary, inappropriate, untimely, and unduly burdensome relief. It
also does not justify the serious, incorrect accusations leveled by the Motion.

1 1. **The Unproduced Documents Are Protected Work Product**

2 The spreadsheets put together by Jason Rice as part of Oracle's investigation, other than
3 those relied upon by Oracle's experts and produced, are protected work product. *See Alinder*
4 *Decl.*, ¶¶7 & 56. SAP provides no justification for invading that protection.

5 Federal law protects against the discovery of documents prepared "in anticipation of
6 litigation or for trial by or for another party or its representative." Fed. R. Civ. P. 26(b)(3). As
7 explained in Section III(A)(1)(a) above, the documents that SAP highlights are spreadsheets that
8 Mr. Rice created at the direction of counsel for the purposes of filing the Complaints in this
9 Action. SAP has made no challenge to Oracle's assertion that the spreadsheets are work product,
10 instead surmising that Mr. Rice's spreadsheets may contain "facts" relevant to mapping (Motion,
11 p. 12) – an assertion that, even if true, does not change the work product nature of the
12 spreadsheets. Those "facts" were selected for compilation into the spreadsheets at counsel's
13 direction. *See Alinder Decl.*, ¶56. Thus, they were properly withheld by Oracle and, as SAP
14 recognizes, were timely and accurately described on Oracle's privilege logs, which SAP has had
15 since May 8, 2008. *See Cowan Decl.*, Ex. K.

16 2. **There Is No Justification for Invading Oracle's Work Product**

17 SAP can only overcome Oracle's legitimate claim to work product protection if it shows
18 "that [it has] substantial need for the materials to prepare [its] case and cannot, without undue
19 hardship, obtain their substantial equivalent by other means." Fed. R. Civ. P. 26(b)(3)(A)(ii).
20 Putting "substantial need" aside, the simple fact that SAP has currently, and has had since before
21 Oracle filed its Complaint, the ability to obtain its own "substantial equivalent" by simply doing
22 the analysis itself, including with the assistance of its own litigation consultants or with the
23 Oracle engineer ordered by Judge Legge, destroys any claim by SAP to Oracle's work product.
24 *See In re Vioxx Products Liability Litigation*, No. MDL 1657, 2007 WL 854251, at*6 (E.D. La.
25 Mar. 6, 2007) ("[Party] cannot rely on [other party's] investigation . . . when they have had
26 access to the same materials by 'other means,' namely in the course of discovery."). SAP has
27 not only had the ability to obtain the "substantial equivalent" to Mr. Rice's spreadsheets, but it
28 had the ability to obtain the *exact* equivalent by using materials produced long ago by Oracle.

SAP's desire to piggyback on Oracle's work product does not justify invading that protection. *See Fletcher v. Union Pacific R.R. Co.*, 194 F.R.D. 666, 671 (S.D. Cal. 2000) ("[M]ere[] expense or inconvenience" does not create undue hardship for a party seeking discovery of work product).

3. Mr. Rice's Spreadsheets Were Produced in a Timely Manner as Part of Expert Discovery

SAP claims that the Rice spreadsheets produced as part of Oracle's expert backup materials should have been produced long before the experts relied on them and before the expert reports were produced. Under SAP's reasoning, Oracle should have produced its work product documents prior to learning whether or not its experts would rely on these documents, and after SAP refused to agree, in January 2008, that production would not constitute waiver. That makes no sense. Given that those spreadsheets were work product, they would never have been produced had they not been relied upon by Oracle's expert witness. Once they were relied upon by Oracle's testifying expert, the Parties' own stipulation, the Federal Rules of Civil Procedure, and applicable case law dictated that they be produced along with the expert report.⁶ *Wixon v. Wyndham Resort Dev. Corp.*, No. C 07-2361-JSW, 2009 U.S. Dist. LEXIS 86349, at *21-22 (N.D. Cal. July 17, 2009), *adopted in part, rejected in part*, 2009 U.S. Dist. LEXIS 86337 (N.D. Cal. Sept. 21, 2009) ("The timing of that production is dictated by *Rule 26(a)(2)(B)*, which specifies 'that disclosure must be accompanied by a written report' containing 'the data or other information considered by the witness.'" (emphasis in original); *see also* Fed. R. Civ. P. 26(a)(2)).

Wixon is on point. In *Wixon*, the defendant produced, along with its expert report, documents that it previously withheld as work product. Like SAP, the plaintiff argued that the

⁶ Stipulation Regarding Expert Discovery (Dkt. No. 275) requires that the Parties produce: (1) "communications or documents on which experts intend to rely or that form the basis for any part of that expert's opinion" and (2) "documents provided to experts (including, without limitation, publications and documents produced in discovery), other than those generated for the purpose of the litigation and/or for the purpose of communicating with the expert, that were considered by the expert in formulating his or her opinion (whether or not they support the opinion)."

defendant should have produced these documents months earlier, prior to the “fact discovery” cut-off date. The Special Master held, and Judge White affirmed, that because the disclosure of expert opinion was timely under Rule 26(a)(2), “to the extent the documents produced [with the Expert Report] were attorney work-product, their production was also timely under the rule.” *Id.* at *22; *see also Wixon v. Wyndham Resort Dev. Corp.*, No. C 07-2361-JSW, 2009 U.S. Dist. LEXIS 86337, at *14 (N.D. Cal. Sept. 21, 2009) (affirming that documents “qualified as work-product and, thus, were produced in a timely fashion when [the party] produced them in connection with [its Expert] Report.”).

The spreadsheets that Mr. Rice created, and that Oracle’s experts relied upon, were timely produced along with the expert reports. The source data was produced long ago. Any materials that continue to be withheld are properly withheld as work product not relied upon by the experts. *See* Fed R. Civ. P. 26(b)(3); *Hickman v. Taylor*, 329 U.S. 495, 511 (1947).

4. **Beyond the Inappropriate Request for Relief Invading Work Product, SAP’s Requests for Relief Are Unnecessary and Unduly Burdensome**

Courts may deny a motion to compel on the ground that the discovery sought would impose an “undue burden” on the responding party (*see* Fed. R. Civ. P. 45(c)(3)(A)(iv)) or that its benefits are outweighed by its burdens. Fed. R. Civ. P. 26(b)(2)(C)(iii). In this instance, on top of an order compelling production of documents and a supplemental interrogatory response, SAP also seeks additional, illogical information that would be enormously burdensome for Oracle to provide. For example, SAP asks that Oracle identify by Bates number “documents Plaintiffs contend they have produced that are **responsive or otherwise related** to RFP Nos. 44, 45, 47 and 51 and Int. No. 7” (emphasis supplied), and then ask for detailed date and author information, among other things. Motion at 3. Providing this level of detail for each document responsive or “related” to the discovery requests at issue is akin to creating a “super-privilege log” for potentially thousands upon thousands of non-privileged documents – obviously a labor-intensive, and perhaps unprecedented, task. *See* Declaration of Martha Jeong in Support of Opposition to Motion to Compel (“Jeong Decl.”), ¶3.

B. **The Court Should Deny SAP’s Motion for Discovery of Irrelevant Documents Maintained by Folger Levin**

On September 22, 2009, SAP sought to open a new vein of irrelevant and burdensome discovery, seeking production of the entire case file of Folger Levin for the case brought by PeopleSoft against Oracle in the Alameda Superior Court in 2003. Despite the Court's skepticism about this request at the last Discovery Conference, SAP has now moved to compel production. SAP's Motion on this topic fails for **three** reasons (apart from the procedural bar discussed above): (1) the requests come too late; (2) the material is unnecessary for SAP's stated purpose; and (3) the materials are almost entirely irrelevant.

First, the request comes too late, consistent with the Court's reasoning on SAP's own motion to preclude Oracle's damages theories. *See* Rule 37 Order, Dkt. No. 482, at 19:28-20:1 ("the parties should be focusing on streamlining this already very large case for trial."); *see also id.* at 19:17-20:1. If the Court would not allow damage theories it ruled emerged in May 2009 into the case, new discovery initiated in September must also be too late.

Second, the materials are unnecessary to show that fear, uncertainty, and doubt ("FUD") drove PeopleSoft support customers to TomorrowNow. The portion of PeopleSoft's publicly-filed Second Amended Complaint that SAP quotes in support of its Motion alleges that Oracle's tender offer was designed to "cripple PeopleSoft's ability to sell its software." Motion at 14. PeopleSoft's allegation was **not** that Oracle was trying to cripple PeopleSoft's ability to **service** its customer base – the one area in which TomorrowNow did compete with PeopleSoft. Thus, on its face, the supposed allegations have no relevance in this case. In addition, SAP's only stated need for these materials is to prove the existence FUD from the tender offer. This need, if it is a credible one, can be met by Oracle's concessions and the publicly-available pleadings and press. As the Court noted, SAP has access to Oracle's and PeopleSoft's 2003 allegations in publicly-available pleadings and press coverage. Moreover, "Oracle [does] not dispute that FUD existed in the marketplace (including from SAP) about how the acquisition might impact the PeopleSoft base." November 10, 2009 Joint Discovery Conference Statement, Dkt. No. 547, at 13:11-13.

Third, most items on SAP's list are overbroad and irrelevant. At best, its request is a fishing expedition. On November 17, 2009, the Court signaled to SAP that the Folger Levin files did not seem particularly relevant:

[T]he fact that the lawsuit was filed and that it lasted a certain amount of time and it had some – and what was public knowledge – probably newspapers and things like that, when we used to have newspapers, you know, that’s what’s relevant to having an impact. But the specifics of, you know, exactly what was said at any particular time and certainly things that weren’t made public, I don’t see how they would have – they’re so tangentially related to damages.

Alinder Decl., Ex. A at 29:20-30:4. While the Court gave SAP the right to look at the Folger Levin pleading index, *id.* at 35:20-36:2, it cautioned that any request would need to be “sufficiently relevant to go to a lot of trouble.” *Id.* at 36:9-10. Though SAP has reduced its request, its list still suffers from the same overbreadth and relevance defects. For example, SAP requests that Oracle produce: (1) motions *in limine* on a variety of irrelevant issues, including Larry Ellison’s character and reputation, post-merger lay-offs, the California Unfair Competition Law, and whether customer hearsay is permitted at trial (McDonell Decl. Ex. I, items 18-20, 25, 42-53, and 56-59); (2) every interrogatory response, without limitation (*id.*, items 5-17 and 21-24); (3) all deposition transcripts in Folger Levin’s possession from the 2003 Alameda Action, without regard to subject matter; and (4) every aspect of every motion for summary judgment (*id.*, items 30-41, 54-55, and 60-64).

None of these is necessary for SAP to achieve its stated goal: to show that FUD drove PeopleSoft support customers to TomorrowNow. To confirm the point, Oracle has undertaken the burden of combing through the materials. Oracle’s review confirmed that any FUD referenced in the documents is based upon publicly-available information such as press releases, news media, analyst notes, and pleadings. *See* Declaration of Lucia MacDonald in Support of Oracle’s Opposition to Motion to Compel (“MacDonald Decl.”), ¶¶2, 4.⁷

For these reasons, the Court should reject SAP’s late request to delve into Folger Levin’s files on the 2003 *PeopleSoft v. Oracle* case. If the Court does not reject SAP’s request in total,

⁷ SAP has refused to limit its request to references to the 350 customers it argued in its Rule 37 motion were the only customers and revenues at issue. However, Oracle’s review revealed that only six of the 64 items on SAP’s list referenced any of the 350 customers whose lost revenue is at issue here. MacDonald Decl., ¶3.

Oracle requests that production be limited to those portions of the items on SAP's wish list that specifically reference any of the TN/SAP customers about which SAP has sought to limit Oracle's lost profits damages.

C. The Court Should Deny SAP's Motion to Compel Production of Post-Litigation Documents

SAP's Motion to Compel the re-collection, review, and production of documents for six custodians fails for **three** reasons (apart from the procedural bar discussed above).

1. SAP Long Ago Abandoned Its Improper Request for Post-Litigation Custodians

SAP first sought the production of post-litigation documents for eleven Oracle employees, including Oracle's three most senior executives, by email on May 20, 2009. *See Alinder Decl., Ex. QQ.* Oracle promptly objected to this request on May 26, 2009, and the Parties met and conferred on June 4, 2009. *See id.*, ¶58. During that session, Oracle stated that it did not see how SAP's request fit within the defined document categories that were the subject of the Expanded Discovery Timeline Agreement, pursuant to which SAP had made the request. *See id.* SAP could not articulate a basis for seeking these particular custodians during that meet and confer, and stated that it would provide that further explanation by email. *See id.* It never did. *See id.* Rather, SAP resurfaced the issue for the first time over five months later, on the afternoon of November 17, 2009. At that time, it still did not provide the further explanation that it had promised in June. *See McDonell Decl.*, ¶15.

Between May and November, SAP had numerous opportunities to raise this issue with Oracle and the Court. SAP did not raise this issue during any of the innumerable discovery meet and confer conferences, emails, and letters between the Parties between June 4 and November 17, 2009. *See Alinder Decl.*, ¶59. After the June 4, 2009 meet and confer, the Parties filed four joint discovery conference statements and, with the Court, held four discovery conferences. *See id.* On each of those occasions, the Parties were supposed to raise all outstanding discovery disputes for prompt resolution. *See id.* SAP never raised this issue. *See id.*

To the contrary, in advance of the September 30, 2009 Discovery Conference, SAP raised concerns that it had about specific custodians. *See September 23, 2009 Joint Discovery*

1 Conference Statement, Dkt. No. 493, at 9:12-25. **This list did not include the post-litigation**
 2 **production issue at all.** Oracle responded with specific details about its production status. *Id.*
 3 at 9:26-10:23. SAP's counsel then stated at the September 30, 2009 Discovery Conference that
 4 SAP was *satisfied* with the state of Oracle's custodian production and pace and that it believed
 5 all custodial production could and should be completed by the close of fact discovery. Alinder
 6 Decl., Ex. RR at 35:9-36:1. Courts have rejected comparable late motions to compel with less
 7 evidence of waiver. *See Khalil v. Transunion, LLC*, No. 08-10303, 2008 WL 4642857, at *2-3
 8 (E.D. Mich. Oct. 20, 2008) (rejecting motion to compel where defendant objected and plaintiff
 9 abandoned the request).

10 In *Khalil*, the court held that the "plaintiff did not have a good faith basis to believe that
 11 the discovery requests made in May, 2008, were viable when the present motion was filed and,
 12 therefore, the motion was not 'substantially justified' within the meaning of Rule 37(a)(5)(B)"
 13 and ordered sanctions. *Id.* at *3. SAP has had many more opportunities to raise this issue than
 14 the plaintiff in *Khalil*, but failed to do so until **after** the final discovery conference had passed,
 15 and after affirmatively stating that Oracle's custodial productions were satisfactory. *See* Alinder
 16 Decl., ¶¶58-59 & Ex. RR at 35:9-36:1. As in *Khalil*, Oracle had appropriately concluded that
 17 SAP had abandoned this request and that it was no longer viable. *See id.* at ¶61.

18 2. The Request for Post-Litigation Custodians Was Not 19 Proper per the Expanded Discovery Timeline Agreement Either

20 In addition, the stated basis for SAP's request, that the documents are called for under the
 21 Parties' Expanded Timeline Discovery Agreement (McDonell Decl., Ex. J), is factually
 22 incorrect. The Parties intended that Agreement to set forth a list of subject matter areas for
 23 document discovery outside the previously-agreed time scope. *See* Alinder Decl., ¶62. No part
 24 of that Agreement states that "the parties are **permitted** to request documents for the expanded
 25 time period for 'key custodians,'" as SAP states. Motion at 17 (emphasis supplied); *see*
 26 McDonell Decl., Ex. J. Oracle did not send SAP a similar list of post-litigation "key
 27 custodians." *See* Alinder Decl., ¶62. Rather, Oracle did as the agreement contemplated and
 28 produced several categories of post-litigation documents up to October 31, 2008 and pre-2004

1 data for 10 key custodians. *See* Jeong Decl., ¶4. That was satisfactory to SAP for six months up
 2 until November 17. Even if the request was timely and easily done (it is not), SAP has not
 3 shown the custodians are “key,” that they meet the criteria of the Expanded Timeline Discovery
 4 Agreement, or that this is anything other than another fishing expedition.

5 **3. SAP’s Request for Post-Litigation Custodians Is Unduly** 6 **Burdensome**

7 Oracle would be prejudiced by having to do this production now. Since most of the data
 8 for these six custodians was collected as far back as April 2007, a full re-collection is necessary
 9 for the expanded time period of March 22, 2007 to October 31, 2008. *See* Jeong Decl., ¶¶5-7. It
 10 was SAP’s own estimation, as previously represented to the Court, that the cost of production
 11 has “averaged around \$100,000 per custodian.” June 24, 2008 Joint Discovery Conference
 12 Statement, Dkt. No. 102, at 14:15-20. Oracle can only estimate how many additional documents
 13 this requested review would require, but conservatively, Oracle estimates that it would cost at
 14 least \$125,000 to collect, process, and review documents for these six custodians for the post-
 15 litigation time period using the applicable search terms, based on an estimated 29,000 document
 16 count. It would require nearly 500 hours of Bingham McCutchen time and would take
 17 approximately six weeks from the time of the interview to production. *See* Jeong Decl., ¶8. SAP
 18 cannot justify imposing this burden. As SAP noted during a recent discovery conference, it is
 19 expensive to keep the discovery machinery in place long after the discovery cut-off and once that
 20 machinery is dismantled, the “ability to produce things rapidly, particularly [inaudible]
 21 custodians or other kinds of issues, become seriously hampered” Alinder Decl., Ex. RR at
 22 36:5-21. At the time, the Court instructed that leading up to the December 4 discovery cut-off:
 23 “I would expect 99.99999 to be done. And if it’s not done, it’s probably just too late.” *Id.* at
 24 37:15-17. Each of SAP’s requests here is “just too late.”

25 **IV. CONCLUSION**

26 Based on the foregoing, Oracle respectfully requests that the Court deny each aspect of
 27 SAP’s Motion to Compel.
 28

1 DATED: January 5, 2010

BINGHAM McCUTCHEN LLP

2
3 By: /s/ Geoffrey M. Howard
4 Geoffrey M. Howard
5 Attorneys for Plaintiffs
6 Oracle USA, Inc., Oracle International
7 Corporation, Oracle EMEA Limited, and
8 Siebel Systems, Inc.
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28